



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/611,649

07/01/2003

Chris Rundfeldt

HUBR-1221

2085

24972 7590 08/11/2009
FULBRIGHT & JAWORSKI, LLP
666 FIFTH AVE
NEW YORK, NY 10103-3198

EXAMINER

KANTAMNENI, SHOBHA

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

08/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/611,649

Applicant(s)

RUNDFELDT ET AL.

Examiner

Shobha Kantamneni

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8-13,15,17,18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8-13,15,17-18,20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/27/2009 has been entered.

Applicant's amendment filed on 06/25/2009, wherein claim 20 has been amended.

Upon further consideration, the rejection of claim 20 under 35 U.S.C. 112, second paragraph, as being indefinite is herein withdrawn.

Claims 1-4, 6, 8-13, 15, 17-18, 20-23 are examined herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 8-13, 15, 17-18, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. (NAUNYN-SCHMIEDEBERG'S ARCHIVES OF

PHARMACOLOGY, vol. 363, no.4 Supplement, 2001, page R85, XP009019486 42nd Spring Meeting of the German Society for Experimental and Clinical Pharmacology and Toxicology; Mainz, Germany; March 13-15, 2001, PTO-1449), and further in view of Hanifin et al., (The journal of Investigative Dermatology, Vo1.107, No.I, July 1996, pages 51-56).

Ehinger et al. disclose the employment of AWD 12281 ((N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide) to treat atopic dermatitis. Experiments with toluene-2,4-diisocyanate (TDI)-sensitized mice was disclosed. TDI challenged mice were treated by topically applying AWD 12281 (0.1-3 %) i.e after an allergic challenge. In some of the experiments with TDI-sensitized mice the AWD was applied topically once or thrice in 24 hours. In that case, "two hours after first treatment, the allergic reaction was challenged by administration of TDI onto the ears". Thus, AWD 12281 was also applied after TDI challenge. See the entire paper.

Ehinger et al. do not explicitly teach that (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide is administered to mice for the first time after an allergic challenge.

Hanifin discloses a method of treatment of atopic dermatitis comprising topical administration of PDE4 inhibitor CP80,633 ointment to patients with atopic dermatitis to treat inflammation i.e application solely after an allergic challenge is taught. Hanifin teaches significant reduction in the inflammation. See Hanifin et al., The journal of Investigative Dermatology, Vo1.107, No.I, July 1996, pages 51-56; abstract; page 52, left hand column; page 52, right hand column under Topical Therapy.

It would have been obvious to a person of ordinary skill in the art at the time of invention to administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide for the first time after an allergic challenge with reasonable expectation of treating atopic dermatitis because 1) Ehinger et al. teach that (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide, a PDE4 inhibitor is known to treat allergic skin diseases such as atopic dermatitis, and 2) Hanifin discloses a method of treatment of atopic dermatitis comprising topical administration of PDE4 inhibitor CP80,633 ointment to patients with atopic dermatitis to treat inflammation i.e application solely after an allergic challenge is taught. Accordingly, one of ordinary skill in the art at the time of invention would have been motivated to topically administer for the first time after an allergic challenge a PDE4 inhibitor, (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide with reasonable expectation of success of treating atopic dermatitis.

It would have been obvious to a person of ordinary skill in the art at the time of invention to administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide up to 48 h after an allergic challenge.

One of ordinary skill in the art at the time of invention would have been motivated to the particular treatment regimen i.e administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide for the first time after an allergic challenge, and to administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide up to 48 h after an allergic challenge because the optimization of result effect parameters e.g., dosage range, dosing regimens, dosing

duration is obvious as being within the skill of the artisan, involving merely routine skill in pharmaceutical art.

Response to Arguments

Applicant argues that "Furthermore, other PDE4 inhibitors besides cilomilast are not effective for the treatment of allergic skin diseases if these are solely administered after the allergic challenge." These arguments have been considered, but not found persuasive. Contrary to applicant's remarks that other PDE4 inhibitor are not effective for the treatment of allergic skin disease if these are solely administered after the allergic challenge, Hanifin discloses a method of treatment of atopic dermatitis comprising topical administration of PDE4 inhibitor CP80,633 ointment to patients with atopic dermatitis to treat inflammation i.e application solely after an allergic challenge is taught. Hanifin teaches significant reduction in the inflammation. See Hanifin et al., The journal of Investigative Dermatology, Vo1.107, No.I, July 1996, pages 51-56; abstract; page 52, left hand colum; page 52, right hand column under Topical Therapy.

It would have been obvious to a person of ordinary skill in the art at the time of invention to administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide for the first time after an allergic challenge with reasonable expectation of treating atopic dermatitis because 1) according to Ehinger et al. (N-3,5-dichloro- 4-pyridinyl)-2-[1 -(4-fluorobenzyl)-5-hydroxy- 1 H-indol-3yl]-2-oxoacetamide is known to treat allergic skin diseases such as allergic dermatitis, and further 2) the optimization of result effect parameters e.g., dosage range, dosing regimens, dosing duration is obvious as being within the skill of the artisan, involving merely routine skill in

pharmaceutical art. Further, as discussed above PDE4 inhibitor CP80,633 treats atopic dermatitis/allergic dermatitis when applied topically to skin inflammation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. as applied to claims 1-4, 6, 8-13, 15, 17-18, and 22 above, in view of Winger (US 5,767,095, PTO-892).

Ehinger et al. is applied as discussed above.

Ehinger et al. does not teach the employment of a pharmaceutical agent, corticosteroid in combination with AWD 12281 in the method of treating atopic dermatitis.

Winger teaches that corticosteroids are known for the treatment of canine atopic dermatitis. See column 25, lines 19-22.

It is generally considered *prima facie* obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. As shown by recited teachings of Ehinger and Winger the instant claims contain two

compounds used for treatment of skin condition such as atopic dermatitis. *In re Kerkhoven*, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

Response to Arguments

Applicant argues that “Claim 20 differs from Ehinger with respect to at least two features. Firstly, Ehinger does not disclose the use of a pharmaceutical combination, i.e. of a corticosteroid in combination with AWD 12-281, but only the use of AWD 12-281 alone. Furthermore, since claim 20 refers back to claim 1, the combination is only administered for the first time after an allergic challenge.” These arguments have been considered, but not found persuasive as discussed above. Further, it is pointed out that applicant is arguing against a single reference when the rejection was based on combination of references.

Applicant argues that “Winger only disclose that corticosteroids are known for treatment of atopic dermatitis of dogs. Consequently, if the skilled artisan had combined the teachings of Ehinger and Winger he would not have arrived at the subject-matter of claims 20.--21 and 23.” These arguments have been considered, but not found persuasive. It is generally considered *prima facie* obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. As shown by recited teachings of Ehinger and Winger the instant claims contain two compounds used for treatment of skin condition such as atopic dermatitis. *In re Kerkhoven*, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 8-13, 15, 17-18, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumer et al. (European Journal of Pharmacology, 446, 2002, pages 195-200, PTO-1449), in view of Hanifin et al., (The journal of Investigative Dermatology, Vo1.107, No.1, July 1996, pages 51-56).

Baumer et al. disclose the employment of AWD 12-281 ((N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide) to treat allergic dermatitis in mice. To obtain an allergic dermatitis, BALB/c mice were sensitized to toluene-2,4-diisocyanate (TDI). TDI challenged mice were treated by topically applying AWD 12281 (0.1-3 %). It is disclosed that AWD 12-281 inhibited the ear swelling significantly 8, 16, 24, and 48 h. See abstract; page 196, right-hand column, paragraph 2-page 197, right-hand column, paragraph 1; page 198, left-hand column, last paragraph-page 199, paragraph 1.

Baumer et al. do not explicitly teach that (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide is administered to mice for the first time after an allergic challenge.

Baumer et al. do not explicitly teach that (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide is administered to mice up to 48 h after an allergic challenge.

Hanifin discloses a method of treatment of atopic dermatitis comprising topical administration of PDE4 inhibitor CP80,633 ointment to patients with atopic dermatitis to treat inflammation i.e application solely after an allergic challenge is taught. Hanifin teaches significant reduction in the inflammation. See Hanifin et al., The journal of Investigative Dermatology, Vo1.107, No.1, July 1996, pages 51-56; abstract; page 52, left hand column; page 52, right hand column under Topical Therapy.

It would have been obvious to a person of ordinary skill in the art at the time of invention to administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide for the first time after an allergic challenge with reasonable expectation of treating atopic dermatitis because 1) Baumer et al. teach that (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide, a PDE4 inhibitor is known to treat allergic skin diseases such as atopic dermatitis, and 2) Hanifin discloses a method of treatment of atopic dermatitis comprising topical administration of PDE4 inhibitor CP80,633 ointment to patients with atopic dermatitis to treat inflammation i.e application solely after an allergic challenge is taught. Accordingly, one of ordinary skill in the art at the time of invention would have been motivated to topically administer for the first time after an allergic challenge a PDE4 inhibitor, (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide with reasonable expectation of success of treating atopic dermatitis.

It would have been obvious to a person of ordinary skill in the art at the time of invention to administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide up to 48 h after an allergic challenge.

One of ordinary skill in the art at the time of invention would have been motivated to the particular treatment regimen i.e administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide after an allergic challenge, and to administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide up to 48 h after an allergic challenge because the optimization of result effect parameters e.g., dosage range, dosing regimens, dosing duration is obvious as being within the skill of the artisan, involving merely routine skill in pharmaceutical art.

Response to Arguments

Applicant's arguments with respect to claims rejection have been considered but are not persuasive as discussed above, and in view of the new ground(s) of rejection presented herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 8-13, 15, 17-18, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofgen et al. (US 6, 251, 923, PTO-1449), and further in view of Hanifin et al., (The journal of Investigative Dermatology, Vo1.107, No.I, July 1996, pages 51-56).

Hofgen et al. discloses hydroxyindoles of the Formula (I), including the instantly elected species (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide for the treatment of skin diseases such as psoriasis, keratosis, atopic dermatitis (allergic dermatitis), eczema. See abstract; column 7, lines 25-34; column 10, EXAMPLE 1. Oily suspensions for topical application comprising other agents such as fatty acid esters is also taught. See column 8, lines 43-45.

Hofgen et al. do not explicitly teach that (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide is administered for the first time after an allergic challenge.

Hanifin discloses a method of treatment of atopic dermatitis comprising topical administration of PDE4 inhibitor CP80,633 ointment to patients with atopic dermatitis to treat inflammation i.e application solely after an allergic challenge is taught. Hanifin teaches significant reduction in the inflammation. See Hanifin et al., The journal of Investigative Dermatology, Vo1.107, No.I, July 1996, pages 51-56; abstract; page 52, left hand column; page 52, right hand column under Topical Therapy.

It would have been obvious to a person of ordinary skill in the art at the time of invention to administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-

indol-3yl]-2-oxoacetamide for the first time after an allergic challenge with reasonable expectation of treating atopic dermatitis because 1) Hofgen et al. teach that (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide, a PDE4 inhibitor is known to treat allergic skin diseases such as atopic dermatitis, eczema, and 2) Hanifin discloses a method of treatment of atopic dermatitis comprising topical administration of PDE4 inhibitor CP80,633 ointment to patients with atopic dermatitis to treat inflammation i.e application solely after an allergic challenge is taught. Accordingly, one of ordinary skill in the art at the time of invention would have been motivated to topically administer for the first time after an allergic challenge a PDE4 inhibitor, (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide with reasonable expectation of success of treating atopic dermatitis.

It would have been obvious to a person of ordinary skill in the art at the time of invention to administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide up to 48 h after an allergic challenge.

One of ordinary skill in the art at the time of invention would have been motivated to the particular treatment regimen i.e administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide after an allergic challenge, and to administer (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide up to 48 h after an allergic challenge because the optimization of result effect parameters e.g., dosage range, dosing regimens, dosing duration is obvious as being within the skill of the artisan, involving merely routine skill in pharmaceutical art.

Response to Arguments

Applicant's arguments with respect to claims rejection have been considered but are not persuasive as discussed above, and in view of the new ground(s) of rejection presented herein.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6, 8-13, 17-18, are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 27-29, 36-38, and 69-84 of co-pending Application No. 10/856034, in view of Hanifin et al., (The journal of Investigative Dermatology, Vo1.107, No.1, July 1996, pages 51-56). Although the conflicting claims are not identical, they are not patentably distinct from each other

because the instant claims are drawn to a method of treating skin disease comprising topically administering N-(3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide, and '034 is drawn to a method of treating atopic dermatitis comprising administering a compound, N-(3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide. The application '034 does not specifically teach the topical administration of the compound for the first time after an allergic challenge in the method therein. It would have been obvious to the person of ordinary skill in the art at the time of invention to administer topically to a subject a therapeutically effective amount of N-(3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide with reasonable expectation of treating a skin disorder. Further, topical administration of compounds is well known for treating skin disorders, and '034 discloses that the compounds therein can be administered topically. See page 14 of '034. Further as discussed above, Hanifin discloses a method of treatment of atopic dermatitis comprising topical administration of PDE4 inhibitor CP80,633 ointment to patients with atopic dermatitis to treat inflammation i.e application solely after an allergic challenge is taught. Hanifin teaches significant reduction in the inflammation. Accordingly, one of ordinary skill in the art at the time of invention would have been motivated to topically administer for the first time after an allergic challenge a PDE4 inhibitor, (N-3,5-dichloro-4-pyridinyl)-2-[1-(4-fluorobenzyl)-5-hydroxy-1H-indol-3yl]-2-oxoacetamide with reasonable expectation of success of treating atopic dermatitis.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments have been considered, but not found persuasive as discussed above.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Monday-Friday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, Ph.D can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni, Ph.D
Patent Examiner
Art Unit : 1617

/SREENI PADMANABHAN/

Application/Control Number: 10/611,649

Page 16

Art Unit: 1617

Supervisory Patent Examiner, Art Unit 1617